



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/694,542	08/09/96	WHITEHOUSE	C 840.052

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EXAMINER

ANDERSON, B

ART UNIT

PAPER NUMBER

2878

DATE MAILED: 11/16/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/694,542

Applicant(s)
WHITEHOUSE ET. AL.

Examiner
BRUCE ANDERSON

Group Art Unit
2878



☒ Responsive to communication(s) filed on Oct 21, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 33-156 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 33-156 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 33-156 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-136 and claims 1-10 of U.S. Patent No. 5,652,427 and 5,689,11 in view of EP 529,885.

Both the Whitehouse patent (427) and Dresch (111) disclose the combination of at least one multipole ion guide which can extend through more than one vacuum chamber, and a time of flight mass spectrometer which may be perpendicular to the at least one ion guide axis. Said ion guide may have four or more multipoles and have collisional gas therein; while said time of flight mass spectrometer may be a reflectron. The ion guide may provide storage volume to ions therein by use of an entrance and exit lens means (claim 6 of Dresch). It is obvious to one of ordinary skill in the art of ion guides that if collisional gas is provided then fragmentation of ions trapped therein

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may be subsequently be detected and unwanted trapped ions may be ejected prior to analysis, as previously stated in the EP reference.

See M.P.E.P. 706.02 (k).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 33-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franzen (878) in view of EP 529,885.

Franzen discloses the basic combination of at least one multipole which may extend into more than one vacuum chamber, and a multipole ion guide/trap 12 which may direct

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selected ions perpendicular to the axis into a time of flight spectrometer. Said multipole ion guide(s) may have more than four pole and guide 12 may have a collisional gas therein.

Furthermore, it would appear that diagraphs 10 and 14 serve the same purpose purpose as applicants' entrance and end electrodes. If a collisional gas is used in ion guide 12 then one may have fragmentation of ions therein, which may be directed into the time of flight spectrometer, as taught by the secondary reference to EP 529,885. Also it would have been obvious to one of ordinary skill in the art that one may have choosen a well known reflectron as the time of flight spectrometer to analyze the selected ions , if so desired.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Franzen and Mordehai have been cited to show other similar devices.
6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ex. Anderson whose telephone number is (703) 308-4851.

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BCA

November 5, 1998

BRUCE ANDERSON
PRIMARY EXAMINER
GROUP 2500-2878

*Bruce C.
Anderson*